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09/866,260	05/25/2001	Timothy L. Beck	9134-0023	5543

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EXAMINER

WINTER, JOHN M

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/866,260

**Applicant(s)**BECK ET AL. *ST***Examiner**

John M Winter

**Art Unit**

3621

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-46, 55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-46 is/are allowed.
- 6) ☒ Claim(s) 35 and 55 is/are rejected.
- 7) ☒ Claim(s) 36-40 and 56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/31/01, 12/13/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-34 are drawn to verification of identification information classified in class 705 subclass 75.
  - II. Claims 35-46,55 are drawn to health care management operations, classified in class 705 subclass 2.
  - III. Claims 47-54 are drawn to medical diagnostic testing, classified in class 660 subclass 300.

The inventions are distinct, each from the other because of the following reasons:

2.  
Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed such as a transport agent and medical device interface. The subcombinations have separate utility such as an agent that automates the procedure and specialized communication interfaces..

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Via Paper filed June 25, 2004 an election was made without traverse to prosecute the of invention II, claims 35-46,55-56. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-34, and 47-54 Have been canceled by the applicant, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 35-46,55-56 have been examined

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardy (US Patent No 6,270,457)

As per claim 35,

Bardy ('457) discloses a first computing device for accessing a medical device operably coupled to a second computing device via a network, the first computing device comprising:

a storage device comprising a plurality of protocol components, a transport agent operably coupled to the storage device and the network, (Figure 2)

The terms "configure second computing device to communicate with a plurality of medical devices in accordance with a plurality of communications protocols supported by the plurality of medical devices " and "the transport agent being adapted to receive from the second computing device identification information associated with a particular medical device operably coupled to the second computing device, to select from the plurality of protocol components of the storage device a protocol component to configure the second computing device for communications with the particular medical device, and transfer to the second computing device via the network the protocol component selected from the plurality of protocol components." is a non-functional descriptive item. The terms "configure second computing device to communicate with a plurality of medical devices in accordance with a plurality of communications protocols supported by the plurality of medical devices " and "the transport agent being adapted to receive from the second computing device identification information associated with a particular medical device operably coupled to the second computing device, to select from the plurality of protocol components of the storage device a protocol component to configure the second computing device for communications with the particular medical device, and transfer to the second computing device via the network the protocol component selected from the plurality of protocol components." could be replaced with other terms. i.e. "adapted to interface with any arbitrary machine", etc and not change the limitations of the claim. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other words **language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation.** See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

As per claim 55,

Bardy ('457) discloses a system for providing access to a medical device, the system comprising:

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a first computing device; a second computing device in communication with the first computing device,(Figure 2).

The terms “The second computing device being adapted to obtain identification information from the medical device, to transfer the identification information to the first computing device, to receive protocol component information from the first computing device that identifies a protocol component to be used by the second computing device to communicate with the medical device, to determine whether the second computing device already has the protocol component identified by the protocol component information, and obtain the protocol component identified by the protocol component information from the first computing device if the second computing device does not already have the protocol component identified by the protocol component information, and wherein the first computing device is adapted to receive the identification information from the second computing device, to identify the protocol component of a plurality of protocol components, to transfer the protocol component information to the second computing device, and to transfer the protocol component to the second computing device if the second computing device does not already have the protocol component identified by the protocol component information” is a non-functional descriptive item. The terms “The second computing device being adapted to obtain identification information from the medical device, to transfer the identification information to the first computing device, to receive protocol component information from the first computing device that identifies a protocol component to be used by the second computing device to communicate with the medical device, to determine whether the second computing device already has the protocol component identified by the protocol component information, and obtain the protocol component identified by the protocol component information from the first computing device if the second computing device does not already have the protocol component identified by the protocol component information, and wherein the first computing device is adapted to receive the identification information from the second computing device, to identify the protocol component of a plurality of protocol components, to transfer the protocol component information to the second computing device, and to transfer the protocol component to the second computing device if the second computing device does not already have the protocol component identified by the protocol component information” could be replaced with other terms. i.e. “adapted to interface with any arbitrary machine”, etc and not change the limitations of the claim. PTO’s guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention “as a whole” would have been obvious at the time of invention to one of ordinary skill in the art. See MPEP 2142. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other words **language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation**. See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims

#### ***Allowable Subject Matter***

Claims 41-46 are allowable over the prior art record.

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Claims 36-40, and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

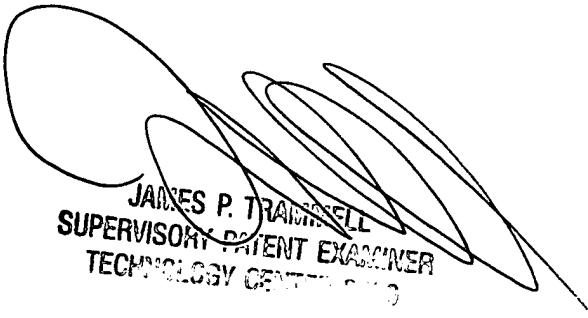
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

September 5, 2004  
JMW



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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